

REMARKS

Upon entry of the present amendment, claims 1 and 4-10 will remain pending in the above-identified application and stand ready for further action on the merits.

Claims 1 and 4-7 have been amended herein. Claims 9 and 10 have been added. Claims 2 and 3 have been canceled.

The instant amendment made herein to the claims does not incorporate new matter into the application as originally filed. For example, the amendments to claim 1 is based on original claims 2 and 3. New claim 9 is based on the disclosure at paragraph 0012 of page 6, paragraph 0023 of page 11 of the specification. Claim 10 is based on claim 7, but depends from new claim 9.

Proper consideration of each of the pending claims (i.e., claims 1 and 4-10) is respectfully requested at present, as is entry of the present amendment.

Rejection under 35 U.S.C. §112, Second Paragraph

At page 2 of the Office Action, claims 1-8 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite because the term “high” is a relative term which renders the claims indefinite.

In claims 1 and 4-6, as currently amended, the term “high” has been deleted. Thus, this rejection has been rendered moot.

Accordingly, Applicants respectfully request that this rejection be withdrawn.

Rejections under 35 USC § 102(b) and 35 USC § 103(a)

At pages 2-4 of the Office Action, claims 1 and 4-8 have been rejected under 35 USC § 102(b) as being anticipated by, or under 35 USC § 103(a) as being unpatentable over Tanaka US'487 (US 6,312,487). Further, claims 2 and 3 have been rejected under 35 USC § 103(a) as being unpatentable over Tanaka US'487.

Distinction over Tanaka US'487

As recited in claim 1, the abrasive slurry of the present invention has the following technical features A and B:

Feature A

“a particle size ratio (D_c/D_p) of the average particle size (D_c) of the colloidal fine particles to the average particle size (D_c) of the colloidal fine particles to the average particle size (D_p) of the abrasive fine particles is 10 or less”

Feature B

“a weight distribution ratio (C_c/C_p) of the particle concentration (C_c) of the colloidal fine particles to the particle concentration (C_p) of the abrasive fine particles is 1 or less”

However, Tanaka US'487 fails to disclose and/or suggest either of the above Features A and B.

Regarding Feature A, Tanaka US'487 fails to disclose and/or suggest Feature A of the present invention, i.e., a specific particle size ratio (D_c/D_p) that is “10 or less”.

Regarding Feature B, Tanaka US '487 also fails to disclose and/or suggest Feature B of the present invention, i.e., a specific weight distribution ratio (C_c/C_p) that is "1 or less".

For example, the cited Tanaka US '487 reference merely discloses an abrasive slurry having a "1.7 or more" weight distribution ratio of the particle concentration (C_c) of SiO_2 to the particle concentration (C_p) of the abrasive fine particles (ZrO_2 , CeO_2 , and Al_2O_3) as described in Experiment Nos. 17 & 18 of Table 1-2 (*see* columns 8-9 of the Tanaka US '487 reference).

Therefore, Tanaka US '487 fails to disclose and suggest the Feature B of the present invention, i.e., the weight distribution ratio (C_c/C_p) of the abrasive slurry of the present invention is 1 or less, and moreover, the Tanaka US '487 reference actually teaches away from Feature B of the presently claimed invention.

Further, a *prima facie* case of obviousness is not established based on the cited Tanaka US '487 reference, since the cited reference fails to disclose and suggest the Features A and B of the present invention.

Unexpected Results

Further, the present invention has unexpected results associated therewith that are not expected from Tanaka US '487. As shown in the attached Declaration under 37 CFR § 1.132 of Mr. Toshiaki ASO, on the basis of the Features A and B mentioned above, the abrasive slurry of the present invention exhibits an excellent dispersion stability for a long time and satisfactory redispersion property and can be used as a dispersant-free abrasive containing substantially no organic dispersant (see Tables 1, 2 and CONCLUSIONS of pages 3-4 of the Declaration). Such a result cannot be expected from Tanaka US '487.

Accordingly, the present invention (claim 1 and dependent claims 4-10) is not anticipated by or obvious over Tanaka US '487. Each of these rejections is respectfully traversed and reconsideration and withdraw thereof is respectfully requested.

CONCLUSION

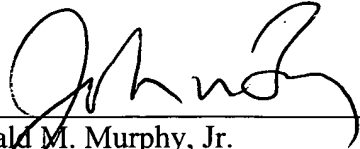
In view of the above amendment, applicants submit the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gerald M. Murphy, Jr. (Reg. No. 28,977) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: **OCT 11 2005**

Respectfully submitted,

By  #32,881
Gerald M. Murphy, Jr.
Registration No.: 28,977
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Rd
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant